

**REMARKS**

This Amendment is a full and timely response to the Office Action dated July 27, 2004. Reexamination and reconsideration are respectfully requested. A Petition to Extend the Time for this response to within the third extended month accompanies this submission.

**Introduction**

Claims 45 to 62 are pending in this application. Claims 45 and 51 were rejected under 35 USC 103(a) as unpatentable over the DESIGN patent to Miller, D378,562. Claims 52, 53 and 62 were rejected under 35 USC 103(a) as unpatentable over Miller (clearly Miller '562) I and further in view of Blackwelder. Claims 46 and 64 were rejected under 35 USC 103(a) as unpatentable over Miller in view of Blackwelder as applied to claims 45, 51 to 53 and 62 above, and further in view of either one of Forrer and Brodbeck. These rejections were explained as "new ground(s) of rejection" on page 4 of the pending action. Each of these rejections is respectfully traversed.

**Incorporation by reference**

On or about May 1, 2004, an Appeal Brief was submitted in this application presenting five (5) issues for consideration. This action is responsive to that Brief on Appeal and alleges that the Applicant's arguments are "moot in view of the new grounds of rejection". In fact, the only new ground of rejection involves: (1) deletion of the reference to "conventional coolers" in points 1 and 3; and (2) altering the grounds of rejection as to claims 45 and 51, covered by points 2 and 3 of the Appeal Brief to one arising under 35 USC §103 relying on Mill D378, 562. Points 4 and 5 remain responsive to the rejections of claims 52, 53 and 62, and claims 46 and 64 when considered in conjunction with point 2. Thus, in summary, the only new ground of rejection is a change from anticipation to obviousness of claims 45 and 51 over Miller D378,562 that also affects points 4 and 5 of the prior issues except that Miller '562 is applied as a section 103 reference not a section 102 reference.

Hence, the arguments in point 1 are repeated. That is, a threshold issue is whether the findings in this Action regarding Miller '946 (different from Miller '562), and Blackwelder are consistent with and not precluded by the findings of the Board in the appeal in the parent application. As such, the applicable arguments and points raised in the Appeal Brief are reiterated as if fully repeated herein.

Here, as there, the Miller '562 patent relied upon is a design patent for an ornamental design of coolers. The Board there held, in language fully applicable to the use of the Miller '562 reference here, that "it is not possible to determine, based on the drawing figures of the references along, whether the lid of the other Miller design patent is affixed to a planar portion of the cooler. In addition, the Board addressed the use of the other Miller design patent in combination with Blackwelder at pages 14 et seq. of the Decision on Appeal. There, the Board said in language that continues to be pertinent to the broader use of a design patent in combination with Blackwelder that, even assuming without holding, that Blackwelder is analogous art, the obviousness rejection is not well founded. There, as here, was nothing in the teachings of the applied reference that would have suggested the desirability and thus the obviousness of the modification of the design patents to Hicks and Miller. See the top of page 15 of the Decision on Appeal.

Thus, simply put, as the Board found, the thrust of the design patents of providing a pleasing ornamental design for a cooler for storing food and beverages, and that of Blackwelder of providing a clothing accessory that may be readily customized to coordinate with a number of different "outfits" are so fundamentally different from one another that a person of ordinary skill in the art would not have found it obvious to modify one in view of the other without improper reliance on appellants disclosure and teachings.

Accordingly, all obviousness rejections based on Miller '562 and Miller in combination with Blackwelder are barred by issue preclusion and/or collateral estoppel according to the prior related Board decision.

Rejection of Claims 45 and 51 as unpatentable over Miller D'562

Claim 45 relates, among other things, to a method of releasably attaching predetermined indicia to an insulating cooler device having an insulating cooler and at least a pair of interchangeable structural members for the cooler. The steps of providing, applying, and releasable affixing are specifically recited. Claim 51 is dependent on claim 45 and recites that the predetermined indicia applied to the respective structural members is a sports logo.

The stated rejection is confusing in several respects: (1) reference to the “Miller patents” at the top of page 3 of the Action, lines 2 and 3 is seemingly inaccurate since only the Miller ‘D562 patent was relied upon; and (2) the first full paragraph on page 3 of the Action is unclear as to whether “Miller” referred to in the first sentence is the same “Miller D378,562” in the second sentence. Assuming that “Miller” and “Miller D378,562” are one and the same, it is not disputed that “Miller” does not teach having a plurality of interchangeable structural members, i.e. lids. What is disputed is the finding that it would have been obvious to one of ordinary skill in the art to make different lids available for the coolers so the coolers could be useful year-round. Indeed, that finding is prompted by a hindsight analysis based on the Applicant’s disclosure not on any fair teaching derived from the Miller D’562 design patent.

Claims 52, 53 and 62 are patentable over Miller D'562 in view of Blackwelder and  
Claims 46 and 64 are patentable over Miller D'562 in view of Blackwelder and further in view  
of either one of Forrer and Brodbeck.

A full and persuasive response to the applicability of a design patent of the type typified by Miller D’562 and Blackwelder has been fully addressed by the reasoning of the Board, and that reasoning applies here as well. Accordingly, both rejections based on that combination either alone or in combination with other references is overcome.

It should be noted that claim 52 recites the manipulative steps in a method of interchanging attachments for an insulating cooler device that include providing a plurality of interchangeable structural members (not well taught by Miller D’562), and steps of releasable affixing, removing and again releasable affixing. The references simply do not teach or suggest

those steps. Claim 53 recites an additional step of applying a releasable affixation device to each of the plurality of attachments. Claim 62 clarifies that the applied logo is a sports logo. None of the references teach these steps or features as clearly recited.

Nor are the recitations of claims 46 and 64 taught by any proper combination of the applied references, for none suggests or implies the steps recited in those claims.

Conclusion

The pending claims are patentable over the art of record.

Respectfully submitted,

Dated: January 27, 2005

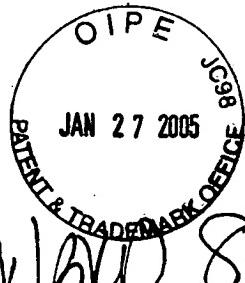
By \_\_\_\_\_  
Ronald P. Kananen  
Registration No.: 24,104  
Attorneys for Applicant

**RADER, FISHMAN & GRAUER, PLLC**  
Lion Building  
1233 20<sup>th</sup> Street, N.W., Suite 501  
Washington, D.C. 20036  
Tel: (202) 955-3750  
Fax: (202) 955-3751

Customer No. 23353

DC136862

In the event additional fees are necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicants hereby petition for any needed extension of time.



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

March 31, 2003

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

a reconsideration / appeal to C.A.F.C  
3-31-03

Ex parte Mary Purvis

Appeal No. 2002-1406  
Application No. 09/437,667

JAN 31 2003  
PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.  
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-26. An amendment after final rejection canceling claims 27-44 has been entered. No other claims are currently pending.

The Invention

It is an objective of appellants' invention to provide a single cooler or container with a set of two or more readily exchangeable tops or sides, each representing, for example, a different sports team of interest. In a first embodiment of the invention (e.g., Figures 1A-1C), a plurality of interchangeable tops 22 bearing different team logos is provided for a single cooler body. Claim 1 is an exemplary claim directed to the first embodiment. In another embodiment of the invention (e.g., Figures 2A, 2B) a plurality of interchangeable attachments 44 bearing different team logos is provided for removable securement to a top or side of the cooler. In this embodiment, the securing means can be a temporary adhesive, hook and loop fasteners, magnets, etc. Claim 6 is an exemplary claim directed to this embodiment.

The Prior Art

The examiner relies upon the following as evidence of anticipation/obviousness of the claimed invention:

The declaration of Examiner Bryon P. Gehman, executed July 19, 2001, pertaining to facts within the personal knowledge of the examiner.<sup>1</sup>

Hicks et al. (Hicks)	D. 325,493	Apr. 21, 1992
Miller et al. (Miller)	D. 369,946	May 21, 1996
Blackwelder	5,803,266	Sep. 8, 1998

---

<sup>1</sup>A copy of the Gehman declaration is attached to this decision.

The Rejections

The following rejections are before us for review:

- (a) claims 6-14, rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (b) claims 1-3, 6, 8, 15, 16, 19, 20 and 23, rejected under 35 U.S.C. § 102(b) as being anticipated by the Gehman declaration;
- (c) claims 15, 16, 19, 20, and 23, rejected under 35 U.S.C. § 102(b) as being anticipated by Hicks;
- (d) claims 15, 16, 19, 20, 23 and 26, rejected under 35 U.S.C. § 102(b) as being anticipated by Miller;
- (e) claims 1-6, 8 and 10, rejected under 35 U.S.C. § 103 as being unpatentable over Hicks; and
- (f) claims 1-26, rejected under 35 U.S.C. § 103 as being unpatentable over Hicks or Miller in view of Blackwelder.

Reference is made to appellant's main and reply briefs (Paper Nos. 12 and 18) and to the examiner's answer (Paper No. 16) for the respective positions of appellant and the examiner regarding the merits of these rejections. The declaration of attorney Ronald P. Kananen executed October 23, 2001 has been submitted in support of appellant's position.<sup>2</sup>

---

<sup>2</sup>A copy of the Kananen declaration is attached to this decision.

Discussion

Rejection (a)

Claims 6-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The criterion for compliance with the second paragraph of 35 U.S.C. § 112 is “whether a claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The examiner’s first rationale in support of this rejection is that the term “said interchangeable attachment” in lines 2-3 of claim 6 lacks a proper antecedent and/or is inconsistent with the term “more than one interchangeable attachment” recited earlier in the claim. However, we believe one skilled in the art would understand the term “said interchangeable attachment” in lines 2-3 as referring to each of the previously recited “more than one interchangeable attachment.”

Next, the examiner considers that the terms “said planar portion” and “said insulating device” appearing at several places in claims 6-14 is improper and indefinite because these terms refer to elements (or portions of elements) that are not positively recited as part of the claimed invention. According to the examiner, only positively recited structure may be referred to by use of the term “said”. We know of no *per se* rule of claim drafting, and the examiner has referred us to no such rule, supporting the examiner’s position in this regard. From our perspective, one skilled in the art would have no difficulty determining which elements recited in the claims are positively recited as part of the claimed subject matter and which are not.

Finally, the examiner considers that dependent claim 8 is unclear in that it states that the "set" of claim 6 "is one of a top and a side" of the insulating device. The examiner's point is well taken. Claim 6 is directed to a "set" comprising "more than one interchangeable attachment" and "means for removably securing said attachment to a planar portion of an insulating device." In contrast, claim 8, which depends from claim 6, states that the "set" of claim 6 "is one of the a top and a bottom side of said insulating device." The language of dependent claim 8 is inconsistent with that of claim 6 and raises questions as to the scope of the dependent claim. This is so because in base claim 6 the insulating device is only inferentially recited, whereas claim 8 states or at least implies that the "set" of claim 6 includes as a positively recited element thereof one of a top and a bottom of the insulating device inferentially recited in the base claim. For this reason, the standing 35 U.S.C. § 112, second paragraph, rejection of claim 8, as well as claim 10 that depends therefrom, will be sustained.

Rejection (b)

Claims 1-3, 6, 8, 15, 16, 19, 20 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Gehman declaration.

In proceeding before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. *In re Morris*, 127

F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In the present case, appellant's specification does not specifically define the terms "set" and "indicia" appearing in the claims. Consistent with appellant's specification, we find the broadest reasonable interpretation of the term "set" to be "a group of articles of uniform design"<sup>3</sup>, and the broadest reasonable interpretation of the term "indicia" to be "an identifying marking used to single out one thing from another."<sup>4</sup>

Considering first independent claim 1, we find the scope of claim 1 to be a "set of interchangeable portions" comprising "more than one said interchangeable portion" with each said portion "having indicia thereon" and being "structurally adapted" to mate with a non-interchangeable portion of an insulating device. We find that neither the "insulated storage device" as a whole, nor the "non-interchangeable portion" thereof, is part of the claimed "set". In addition, we note that claim 1 does not require the interchangeable portions to be different in any way from one another.

The Gehman declaration relied upon by the examiner in support of this rejection states, among other things, that (1) Examiner Gehman personally owned "since the mid 1980s" a

---

<sup>3</sup>See Webster's Third International Dictionary of the English Language Unabridged, G. & C. Merriam Company, copyright © 1971, wherein the noun "set" may mean "39 a: a group of articles of uniform design."

<sup>4</sup>See Webster's Third International Dictionary of the English Language Unabridged, G. & C. Merriam Company, copyright © 1971, wherein "indicia" may mean "b : an identifying marking or verbal statement used to single out one thing from another . . . or to serve as directional guides."

"Coleman six-pack cooler" comprising "a white molded plastic base portion and a blue molded plastic separable lid," (2) at the time of purchase "coolers of the same size that comprised a white molded plastic base portion and a green molded plastic separable lid, and coolers that comprised a white molded plastic base portion and a red molded plastic separable lid, were also on sale," and (3) "[t]he white molded plastic base portions were all of the same construction, while the lids only differed in the color of plastic chosen to provide the lid." The examiner asserts that (4) "[a]ccordingly, the merchant selling these coolers and the Coleman organization, at some time, each retained a set of interchangeable portions for an insulated storage device, any one white molded plastic base portion being usable with any one of the blue, green or red lids."

Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference.

*See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The law of anticipation does not require that the reference teach what an appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

We understand assertion (4) of the Gehman declaration to mean that at various points in the manufacture and marketing of Coleman six-pack coolers there existed a collection or assemblage of said coolers, each said cooler consisting of a cooler base portion and a colored separable lid. It is

our view that claims 1-3 "read on" such a collection or assemblage of said Coleman six-pack coolers. More particularly, the separable lids of the collection or assemblage would comprise a "set" of interchangeable portions in that the lids constitute a group of articles of like design. While we appreciate that each lid of the collection or assemblage of coolers would be associated with a particular base portion such that there would be a one-to-one correspondence between cooler base portions and cooler lids, this circumstance does not preclude the collection or assemblage of coolers from anticipating claims 1-3. The claim term "set" does not define a collection of interchangeable portions that distinguishes over the lids of the prior art collection or assemblage of coolers because, among other things, the non-interchangeable portion of the insulated storage device is not positively recited as a part of the claimed subject matter. Further, because claim 1 is in open ended "comprising" format, it does not preclude the existence of cooler base portions in addition to the base portion the interchangeable lids are adapted to mate with. Concerning the requirement that the interchangeable portions have indicia thereon, the color of the lids of the Coleman six-pack coolers comprises "indicia" in that it may serve as an identifying marking to single out a particular lid from a lid of a different color.

In light of the foregoing, we will sustain the examiner's rejection of claims 1-3 as being anticipated by the Gehman declaration.

Appellant's arguments in the main and reply briefs, as well as the declaration of attorney Ronald P. Kananen in support thereof, have been considered. For the most part, our position with

respect to appellant's arguments and evidence (i.e., the Kananen declaration) should be clear from our reasoning as set forth above. We add the following for emphasis.

Regarding the examiner's position that Coleman had in its possession a set of interchangeable different colored cooler tops for use in conjunction with standard white containers, appellant maintains on page 3 of the reply brief that "[i]t is equally probable that Coleman only provided a top/bottom cooler set, without consideration of an additional interchangeable top for a given bottom." As should be apparent from our discussion above, our position with respect to the anticipation rejection of claims 1-3 based on the Gehman declaration does not depend on a plurality of additional interchangeable tops for a given bottom being provided at any particular point in time. As indicated above, the term "set" is a broad term that does not distinguish over the lids of the prior art collection or assemblage of coolers. Moreover, claims 1-3 are broad in scope in the sense that they do not preclude the presence of cooler base portions in addition to the base portion the interchangeable lids are adapted to mate with. Accordingly, the lids of a collection or assemblage of Coleman six-pack coolers anticipate the "set" of interchangeable portions claimed in claims 1-3.

Turning to claims 6, 8, 15, 16, 19, 20 and 23, independent claim 6 is directed to a "set" comprising more than one interchangeable attachment and means for removably securing the interchangeable attachment to a *planar portion* of an insulating device. Independent claim 15 is directed to an "attachment device" comprising a structural member and an affixation device,

wherein the structural member and the affixation device are dimensioned to releasably affix the structural member to a *substantially planar portion* of an insulating storage device.

The Gehman declaration does not set forth any particulars of the interface connection between the lid and base of the Coleman six-pack cooler beyond the statement that "any one white molded plastic base portion [is] usable with any one of the blue, green or red lids." Nevertheless, in explaining the rejection of claims 6 and 15, the examiner states (answer, page 6) that "the top of the Coleman structure has mating structure to fix the top of a *planar* portion to the container . . ." (emphasis added).

The initial burden of establishing a basis for denying patentability to a claimed invention based on prior art rests upon the examiner. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In order to satisfy this burden, the examiner has the duty of supplying a *factual basis* to support the rejection he advances. See, for example, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). In the present case, the factual basis for the examiner's rejection is the Gehman declaration. Unsupported statements made by the examiner in the answer that serve to expand or add to the Gehman declaration, and in particular the statement on page 6 of the examiner's answer to the effect that the top of the Coleman six-pack cooler has mating structure to fix the top to a *planar* portion of the container, are not part of the factual basis.<sup>5</sup> Based on the

---

<sup>5</sup>Maintaining a line of distinction between statements made by an examiner in a declaration and statements made by that same examiner in an Office action is not a matter of (continued...)

record before us, there is nothing in the factual basis for the rejection that supports the examiner's position as set forth in the answer that the cooler of the Gehman declaration has mating structure to fix the top to a *planar* portion of the container. We are therefore constrained to reverse the anticipation rejection of claims 6 and 15, as well as claims 8, 16, 19, 20 and 23 that depend therefrom, based on the Gehman declaration.

Rejections (c) and (d)

Claims 15, 16, 19, 20 and 23 stand rejected as being anticipated by Hicks and claims 15, 16, 19, 20 23 and 26 stand rejected as being anticipated by Miller.

As noted above, independent claim 15 is directed to an "attachment device" comprising a "structural member" and an "affixation device," wherein the structural member and the affixation device are dimensioned to *releasably* affix the structural member to a *substantially planar* portion of an insulating storage device. Claims 16, 19, 20, 23 and 26 each depend from claim 15.

Hicks and Miller are design patents for the ornamental design of coolers. Accordingly, the drawing figures constitute essentially the entire disclosure. In rejecting claim 15 as being anticipated by the coolers of Hicks and Miller, the examiner finds correspondence between the

---

<sup>5</sup>(...continued)

form over substance. Statements made in a declaration are made with knowledge that willful false statements are punishable by fine or imprisonment. It is for this reasons that such statements are treated as evidence. The same cannot be said of unsupported statements made by an examiner in an Office action.

claimed "structural member" and the lids of the coolers of the references and finds correspondence between the claimed "affixation device" and the joint or engagement between the lids and the cooler bodies of the references. According to the examiner "the structural member and affixation device [of each reference are] dimensioned as to *releasably* affix to an insulating cooler device at a *planar* portion (at least the sides of the container and conventionally the topmost portion of the container in either Hicks et al or Miller et al)" (answer, page 7; emphasis added).

Anticipation cannot be predicated on an ambiguous reference. See *In re Turlay*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). In the present case, it is not possible to determine, based on the drawing figures of the references alone, whether the lid of Hicks is *releasably* affixed to the cooler, or whether the lid of Miller is affixed to a *substantially planar* portion of the cooler, the examiner's unsupported statement to the contrary notwithstanding. For these reasons, the anticipation rejection of claims 15, 16, 19, 20 and 23 based on Hicks, and the anticipation rejection of claims 15, 16, 19, 20 23 and 26 based on Miller, cannot be sustained.

Rejection (e)

Claims 1-6, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hicks.

Claim 1 is directed to a "set of interchangeable portions" comprising "more than one said interchangeable portion" with each said portion "having indicia thereon" and being "structurally adapted" to mate with a non-interchangeable portion of an insulating device. Claims 2-5 depend

Appeal No. 2002-1406  
Application No. 09/437,667

either directly or indirectly from claim 1. Claim 6 is directed to a "set" comprising "more than one interchangeable attachment" and "means for removably securing" the interchangeable attachment to a planar portion of an insulating device. Claims 8 and 10 depend either directly or indirectly from claim 6.

The design patent to Hicks discloses two embodiments of the ornamental design for a cooler, the Figures 1-7 embodiment and the Figures 8-14 embodiment. In rejecting these claims as being anticipated by Hicks, the examiner states that Hicks discloses "a set (the lids of Figure 1 and Figure 8) of interchangeable portions of an insulating device, each interchangeable portion having a different indicia thereon" (answer, page 8). As to claim 6, the examiner further states that "Hicks et al further disclose an insulating device" (answer, page 8). In the "Response to Arguments" section of the answer, the examiner further explains that "the two different designs [of Hicks] [are] obviously interchangeable" and that "the rejection is made based on the obviousness of interchanging elements of the two embodiments" (answer, pages 12-13).

While we appreciate that Hicks discloses two cooler design embodiments, each embodiment is a separate and distinct cooler design. We do not view Hicks as teaching or suggesting that the design features or structural elements of one embodiment may be interchanged with those of the other. Accordingly, the § 103 rejection of claims 1-6, 8 and 10 based on Hicks cannot be sustained.

Appeal No. 2002-1406  
Application No. 09/437,667

Rejection (f)

Claims 1-26 stand further rejected under 35 U.S.C. § 103 as being unpatentable over Hicks or Miller in view of Blackwelder.

Blackwelder relates to a clothing accessories kit having interchangeable ornaments. As set forth in the abstract, the accessories kit

allow[s] a user to coordinate a clothing accessory with a variety of outfits without the expense of purchasing a separate clothing accessory for each outfit. The accessories kit includes a clothing accessory and a plurality of decorative, interchangeable ornaments for attachment to the clothing accessory. At least one of the ornaments is secured to the exterior surface of the clothing accessory by a VELCRO® fastener. The accessories kit further includes a storage container for conveniently organizing the clothing accessory and the plurality of ornaments therein.

In rejecting the appealed claims as being unpatentable over Hicks or Miller in view of Blackwelder, the examiner appears to take the position that it would have been obvious to one of ordinary skill in the art in view of Blackwelder to modify the coolers of Hicks and/or Miller such that the indicia on the lids of the coolers is removable and interchangeable with other indicia.

Appellant argues, first, that Blackwelder constitutes nonanalogous art. In the view we take in this case, even if we assume that Blackwelder is analogous art, the obviousness rejection based on Hick or Miller in view of Blackwelder is not well founded.

Having carefully considered the examiner's position in maintaining this rejection, we conclude that there is nothing within the teachings of the applied references which would have suggested the desirability, and thus the obviousness, of the modification of Hicks and Miller

proposed by the examiner. While it is true that an objective of Blackwelder is to improve the appearance of accessories for clothing by providing interchangeable ornaments for attachment thereto, we see no reasonable basis for modifying the cooler designs of Hicks and/or Miller by making surface ornamentations thereof removable and interchangeable, as apparently proposed by the examiner, in light of Blackwelder. Simply put, the thrust of Hicks and Miller of providing a pleasing ornamental design for a cooler for storing food and beverages, and that of Blackwelder of providing a clothing accessory that may be readily customized to coordinate with a number of different "outfits" in order to reduce the expense of providing specific accessories for each "outfit", are so fundamentally different from one another that we do not consider that a person of ordinary skill in the art would have found it obvious to modify one in view of the other without improper reliance on appellant's disclosure and teachings. This being the case, the examiner's rejection of claims 1-26 based on Hicks or Miller in view of Blackwelder will not be sustained.

Remand

This case is remanded to the examiner for consideration of the following matters.

Our reversal of the standing § 102 rejection of claims 6, 8, 15, 16, 19, 20 and 23 based on the Gehman declaration was predicated on the fact that the Gehman declaration did not contain sufficient details concerning the construction of the Coleman six-pack cooler in the examiner's possession. As set forth in M.P.E.P. §2144.03, when the examiner relies on facts within the examiner's personal knowledge in order to reject a claim, the data should be stated *as specifically as*

*possible, and the facts must be supported by an affidavit or declaration* when called for by appellant. The examiner has not done this. Accordingly, the examiner should consider the patentability of, for example, claims 6 and 15 in view of the specific construction of the Coleman six-pack cooler stated to be in the examiner's possession. In the event the examiner is of the view that said cooler anticipates or renders obvious any of appellant's claims, the examiner should (1) execute a new declaration specifically setting forth the structural details of the Coleman cooler, and (2) enter a new rejection based on the facts presented in the newly executed affidavit or declaration. The specifics of the cooler's construction may be set forth in the affidavit or declaration in any form deemed appropriate by the examiner (e.g., photographs, sketches, etc.).

As should be apparent from our analysis of the claims, appellant's claims are broad in scope. The examiner should consider the patentability of appellant's claims in light of conventional arrangements of known articles of manufacture that one would encounter on a daily basis. For example, claim 1 would appear to be anticipated by a stack of conventional plastic lids for use with disposable foamed coffee cups that one would encounter at a self service beverage station of a convenience store. In this regard, the stack of lids comprises "a set of interchangeable portions" for an insulated storage device (the disposable foamed cup) and typically are imprinted or embossed with indicia (e.g., "CAUTION HOT"). In this same vein, claims 6 and 15 would appear to be anticipated by a plurality of conventional refrigerator magnets affixed to the door of a refrigerator, it

Appeal No. 2002-1406  
Application No. 09/437,667

being noted that such magnets typically include indicia in the form of a decorative appearance and/or written words.

Summary

The rejection of claims 6-14 under 35 U.S.C. § 112, second paragraph, is affirmed as to claims 8 and 10, but is reversed as to claims 6, 7, 9 and 11-14.

The rejection of claims 1-3, 6, 8, 15, 16, 19, 20 and 23 as being anticipated by the Gehman declaration is affirmed as to claims 1-3, but is reversed as to claims 6, 8, 15, 16, 19, 20 and 23.

The rejection of claims 15, 16, 19, 20, and 23 as being anticipated by Hicks is reversed.

The rejection of claims 15, 16, 19, 20, 23 and 26 as being anticipated by Miller is reversed.

The rejection of claims 1-6, 8 and 10 as being unpatentable over Hicks is reversed.

The rejection of claims 1-26 as being unpatentable over Hicks or Miller in view of Blackwelder is reversed.

In addition, this case is remanded to the examiner for consideration of the manners set forth above.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

Appeal No. 2002-1406  
Application No. 09/437,667

whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.196(b) provides:

Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

The effective date of the affirmance in this case is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

This application, by virtue of it's "special" status, requires immediate action, see MPEP § 708.01.

Appeal No. 2002-1406  
Application No. 09/437,667

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; REMANDED

**IRWIN CHARLES COHEN**  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

**JOHN P McQUADE**  
Administrative Patent Judge

)  
)  
)  
)  
)  
)  
)  
)  
)  
)  
) BOARD OF PATENT  
)  
) APPEALS  
)  
) AND  
)  
) INTERFERENCES

LJS/lp

Appeal No. 2002-1406  
Application No. 09/437,667

RADER, FISHMAN & GRAUER PLLC  
SUITE 501  
1233 20<sup>TH</sup> STREET, NW  
WASHINGTON, DC 20036